

REMARKS

In the Office Action, claim 132 is rejected under 35 U.S.C. §112, first paragraph; claim 132 has been rejected under the judicially created doctrine of obviousness-type double patenting; and claim 133 has been objected. Applicants believe that the rejections have been overcome or are improper in view of the amendments and for the reasons set forth below.

At the outset, claim 133 has been rejected as previously discussed. However, the Patent Office asserts that claim 133 would be allowable if rewritten in independent form. In response, claim 133 has been amended to independent form. Thus, claim 133 should be allowed. Applicants further note that claims 141-144 have been allowed as further indicated in the Office Action.

The Patent Office has rejected claim 132 under 35 U.S.C. §112, first paragraph. More specifically, the Patent Office alleges that the subject matter as defined in claim 132 fails to meet the enablement and restriction requirements pursuant to 35 U.S.C. §112, first paragraph. Applicants believe that the enablement and written description rejections are improper.

With respect to enablement, Applicants believe that the specification provides sufficient support for one skilled in the art to readily practice the claimed invention as defined in claim 132. At the outset, the specification lists a number of different plants illustrative of the present invention. See, specification, pages 107-108. Contrary to the Patent Office's position, this list provides sufficient support for a starting plant cell that is contacted with a recombinant DNA construct as defined in claim 132.

Further, the specification provides additional support and guidance that can be readily utilized by one skilled in the art to prepare a transgenic plant cell as claimed in claim 132. For example, general support for the claimed subject matter can be found in the specification, such as, on page 20, at line 5 to page 21 at line 15. A more detailed description illustrative of the present invention as claimed can be found in the specification, for example, on pages 52 to 62 that relates to recombinant constructs with centromere sequences and further the discussion that relates to transformed host cells and transgenic plants as detailed on pages 77 to 84. Moreover, the specification provides working examples, such as Example 6, that are illustrative and support the claimed subject matter as even admitted by the Patent Office.

Based on at least these reasons, Applicants believe that the specification provides sufficient support and guidance to one skilled in the art such that the subject matter as defined in claim 132 can be readily practiced. Therefore, Applicants believe that the enablement requirement has been satisfied.

With respect to the written description requirement, Applicants believe that the specification provides sufficient support such that one skilled in the art would recognize that Applicants were in possession of the subject matter as claimed in claim 132 at the time of filing. For example, Applicants have provided the nucleic acid sequence of a plant centromere. This will allow one skilled in the art to obtain centromere sequences from virtually any species. See, specification, page 62, at lines 2-4.

Further, the specification details a number of methods which can be employed to isolate such centromeres: (1) utilization of conserved sequences (see, specification, pages 62 and 63); (2) identification of centromere-assisted characteristics (see, specification, page 63); (3) utilization of centromere-associated proteins (see, specification, pages 64-71); and (4) genetic mapping based approaches (see, specification, pages 71-73). Moreover, the specification provides a number of different examples of plants illustrative of the subject matter as claimed in claim 132 as previously discussed. Therefore, Applicants believe that the written description requirement has been satisfied based on at least these reasons.

Accordingly, Applicants respectfully request that the rejections of claim 132 under 35 U.S.C. §132 be withdrawn.

In the Office Action, claim 132 is rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1 and 6 of U.S. Patent No. 6,156,953. Applicants believe that this rejection is improper. Indeed, the Patent Office admits that the alleged, conflicting claims are not identical. Further, Applicants believe that the subject matter as defined in claim 132 and as defined in claims 1 and 6 of U.S. Patent No. 6,156,953 are patentably distinct contrary to the Patent Office's position. Therefore, Applicants respectfully request that the rejection of claim 132 under the judicially-created doctrine of obviousness-type double patenting be withdrawn.

For the foregoing reasons, Applicants respectfully submit that the above-identified patent application is now in a condition for allowance and earnestly solicit reconsideration of same.

Respectfully submitted,

BELL, BOYD & LLOYD LLC



BY _____

Robert M. Barrett
Reg. No. 30,142
P.O. Box 1135
Chicago, Illinois 60690-1135
Phone: (312) 807-4204

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